

## REMARKS

### Overview

The current Office Action dated December 13, 2007 rejected the pending claims as follows: claims 16, 21, 24, 28, 85-86 and 88-93 under 35 U.S.C. § 102(e) as allegedly being anticipated by Hazzard et al. (U.S. Patent Application No. 2005/0125389).

Applicants hereby traverse the rejections of the claims, as discussed below. Thus, claims 16, 21, 24, 28, and 85-93 are pending, and claims 17-20, 22-23, 25-27 and 29-84 are currently withdrawn.

### Analysis

As part of the prior Amendment filed on November 5, 2007, Applicants filed a Declaration Of Prior Invention under 37 CFR 1.131 (referred to herein as “the prior Declaration”) to demonstrate that Applicants diligently pursued the invention from a time prior to the December 9, 2003 filing date of the Hazzard patent application, until the filing of the present patent application on January 27, 2004. The Examiner previously agreed that Applicants have demonstrated conception of the invention prior to the December 9, 2003 filing date of the Hazzard patent application.

The current Office Action indicated the following regarding the prior Declaration:

the applicant has accounted by affirmative acts diligence from December 17, 2003, to January 27, 2004. However, the applicant has not provided a specific date prior to December 9, 2003, the beginning of the period from which diligence is required. It is impossible to establish whether the diligence requirement is met because there is no date from which to determine whether the applicant was diligent. . . . The applicant has not met the diligence requirement because he has not accounted for the entire period during which diligence is required by either affirmative acts or acceptable excuses. Therefore, the Declaration is ineffective to overcome the Hazzard reference.

Office Action dated December 13, 2007, pages 7-8, emphasis added.

Applicants thank the Examiner for the acknowledgment that Applicants have established diligence from December 17, 2003, to the January 27, 2004 filing date of the present application.

Nonetheless, Applicants request that the finality of the current Office Action be withdrawn, and the prior Declaration be reconsidered with respect to a determination of diligence between December 9, 2003 and December 17, 2003. In particular, despite the statement

indicated above from the current Office Action, Applicants' prior Declaration did establish one or more specific dates prior to December 9, 2003 in which diligence-related activities occurred. For example, attention is directed to numbered paragraph 5 on page 2 of the prior Declaration, which indicates the following:

5. . . . before the December 9, 2003 filing date of Hazzard, I began preparation of the above-referenced patent application, and spent at least 16 hours on activities related to preparation of the application, including on November 11, 2003. During the indicated time period from December 8, 2003 to January 27, 2004, I spent over 40 additional hours on the application preparation, and performed activities related to application preparation every week during the indicated time period, beginning with the week of December 14, 2003. . . .

Declaration filed November 5, 2007, page 2, emphasis added.

Applicants also discussed this November 11, 2003 date in the Amendment filed November 5, 2007 that accompanied the prior Declaration. Thus, Applicants have demonstrated that activities related to the preparation of the present patent application occurred on November 11, 2003, which is prior to the December 9, 2003 filing date of Hazzard.

Since the finding in the current Office Action of an alleged lack of a showing of diligence between December 9, 2003 and December 17, 2003 was based on the assertion that the prior Declaration did not provide a specific date prior to December 9, 2003, and since the prior Declaration did in fact demonstrate diligence-related activities on a particular date prior to December 9, 2003, Applicants request reconsideration of the prior Declaration. Furthermore, since the finality of the current Office Action is based on the alleged lack of a showing of diligence between December 9, 2003 and December 17, 2003, Applicants request that the finality of the current Office Action be withdrawn in light of Applicants' prior demonstration of diligence for the period between December 9, 2003 and December 17, 2003.

As discussed in greater detail in the prior Amendment filed November 5, 2007, Applicants' activities related to preparation of the present patent application are believed to clearly establish diligence. In general, periods of time such as 4 months and 6 months during which attorneys prepared patent applications have been found to satisfy diligence, including when the attorneys were also working on other projects and spent significant periods of time between diligence-related activities. For example, in *Gould v. General Photonics Corp.*, 534 F.Supp. 339 (N.D. California 1982), the court concluded that "[f]rom December 2, 1958 to April 6, 1959 [a period of over 4 months], Mr. Keegan diligently applied himself to the preparation and filing of Gordon

Gould's original applications (filed on April 6, 1959)," although the court did not list particular dates on which diligence-related activity occurred. In a 1994 decision by the Board of Patent Appeals and Interferences (*English v. Ausnit*, Interference No. 102,361, 38 USPQ2d 1625, 1994), however, the Board did recite attorney actions (listed below) that occurred over a 6-month period in which the attorney prepared and filed a patent application, and the Board concluded that "this evidence establishes attorney diligence for the period beginning 20 June 1986 and ending with Ausnit's 22 December 1986 filing date."

June 20, 1986 – inventor sent letter requesting that attorney prepare patent application

June 25 – attorney received request to prepare patent application; read and studied attached sketches

June 26 – case was docketed and assigned to other attorneys; sketches given to drafting

Sept. 3 – drafting finished

Nov. 11 – attorney finished draft of application

Nov. 12 – typing of draft application completed

Nov. 20 – application papers mailed to inventor

<date unclear> - inventor requested modifications to draft application

Dec. 3 – revised application sent to inventor

Dec. 9 – inventor mailed signed application papers to attorney

Dec. 15 – attorney receives the signed application papers

Dec. 22 – attorney files application with the Patent Office

Thus, in that case, two periods of over 2 months each (from June 26 to September 3, and from September 3 to November 11) occurred without any indication of particular diligence-related activity, as well as numerous other shorter periods of time (*e.g.*, 8 days between completing the preparation of the draft application and sending it to the inventor for review, 7 days between receiving executed application papers and filing the patent application, etc.), and diligence was nonetheless established.

Accordingly, Applicants submit that the shorter periods of inactivity that occurred in this case during the relevant period until December 17, 2003 clearly demonstrate sufficient diligence.

Furthermore, even if Hazzard were valid prior art, the pending claims are nonetheless patentable over Hazzard, as discussed in greater detail in the Amendment filed November 5, 2007. In particular, each of the pending claims as rejected includes features and provides functionality not disclosed by Hazzard, and thus is allowable over that reference.

Accordingly, for all of the reasons discussed above, the rejection of the pending claims based on Hazzard is traversed, and the pending claims are thus allowable over the cited prior art. Applicants thus request that the finality of the current Office Action be withdrawn, and that all pending claims be timely allowed.

#### Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable, as are the withdrawn claims that depend from the independent method claim 16. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 694-4815.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,  
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